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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/787,197	02/27/2004	Katsumi Takehara	58647-180	4572
7590	11/27/2006			EXAMINER HOEKSTRA, JEFFREY GERBEN
Kenneth L. Cage McDERMOTT, WILL & EMERY 600 13th Street, N.W. Washington, DC 20005-3096			ART UNIT 3736	PAPER NUMBER

DATE MAILED: 11/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/787,197	TAKEHARA, KATSUMI
	Examiner Jeffrey G. Hoekstra	Art Unit 3736

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 21 September 2006.

2a)  This action is **FINAL**.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4)  Claim(s) 1-26 is/are pending in the application.  
4a) Of the above claim(s) 1-13 and 20-26 is/are withdrawn from consideration.  
5)  Claim(s) \_\_\_\_\_ is/are allowed.  
6)  Claim(s) 14-19 is/are rejected.  
7)  Claim(s) \_\_\_\_\_ is/are objected to.  
8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on 27 February 2004 is/are: a)  accepted or b)  objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date . . . . .  
4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_ .  
5)  Notice of Informal Patent Application  
6)  Other: . . . . .

**DETAILED ACTION**

***Election/Restrictions***

1. Applicant's election of Species A, drawn to claim 19, in the reply filed on 09/21/2006 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
2. Claims 20-26 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 09/21/2006.
3. It is noted claims 14 and 18 are generic.

***Priority***

4. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

***Information Disclosure Statement***

5. The information disclosure statement(s) (IDS) submitted on 02/27/2004 and 07/13/2004 is/are acknowledged. The submission is in compliance with the provisions of 37 CFR 1.97 and 1.98. Accordingly, the examiner is considering the information disclosure statement(s).

***Drawings***

6. The drawings are objected to because the abscissa and ordinate require labels in Figure 3. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the examiner does not accept the changes, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Specification***

7. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 14-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Kamada et al (US 2001/0007924 A1).

10. For claims 14 and 17, Kamada et al discloses a body composition measuring apparatus as broadly as structurally claimed, comprising:

- an electric current applying unit (21) for applying a variable electric current to a living body (paragraphs 33 and 42);
- a voltage measuring unit (25) for measuring a voltage (paragraphs 33 and 43);
- a bioelectrical impedance computing unit (S10) for computing a parameter (the bioelectrical impedance vector positively recited in paragraph 45) associated with a bioelectrical impedance of a measured body part from the applied electric current and the measured voltage at a given frequency (paragraphs 44-47);
- a correcting unit (S15 and S16) for correcting the parameter value associated with the measured bioelectrical impedance by use of a parameter (the ICW/ECW positively recited in paragraph 62) representing an intracellular/extracellular fluid ratio which is included in the parameter value of the bioelectrical impedance measured at a given frequency (paragraph 42); and

- a body composition computing unit (Block 1) for computing an index (S19)  
associated with a body composition based on the corrected parameter value  
associated with the bioelectrical impedance.

11. For claim 15, Kamada et al discloses a body composition measuring apparatus, wherein the given frequency is the frequency of the electric current applied to the living body for estimation of the body composition as best seen in Figure 10 (paragraph 42).

12. For claim 16, Kamada et al discloses a body composition measuring apparatus, wherein the given frequency is a frequency different from the frequency of the electric current applied to the living body for estimation of the body composition as best seen in Figure 10 (paragraph 42).

13. For claim 18, Kamada et al discloses a body composition measuring apparatus capable of computing the following mathematical relation: when the parameter associated with the bioelectrical impedance which has been corrected by the parameter associated with the bioelectrical impedance which represents the intracellular/extracellular fluid ratio is  $P'$ , the correction of the parameter associated with the bioelectrical impedance in the correcting unit is made in accordance with the following correction expression:  $P' = f(P, \alpha) = (K)(P^A)(\alpha^B) + C$  wherein  $f(P, \alpha)$  is a correction function represented by parameters  $P$  and  $\alpha$ ,  $P'$  is the corrected parameter associated with the bioelectrical impedance,  $P$  is the measured parameter associated with the bioelectrical impedance,  $\alpha$  is the parameter associated with the bioelectrical impedance which represents the intracellular/extracellular fluid ratio, and  $A$ ,  $B$ ,  $C$  and  $K$  are constants.

14. For claim 19, Kamada et al discloses a body composition measuring apparatus capable of computing the following mathematical relation: the parameter  $\alpha$  associated with the bioelectrical impedance, which represents the intracellular/extracellular fluid ratio, is expressed as follows by use of a phase difference  $\phi$  between the waveform of the alternating current applied from the electric current applying means to the living body and the waveform of the voltage measured by the voltage measuring means at the time of measurement of the bioelectrical impedance:  $\alpha = 1/\phi$ .

15. For claims 18 and 19, the examiner notes the determination of patentability in a product-by-process claim is based on the product itself, even though the claim may be limited and defined by the process. That is, the product in such a claim is unpatentable if it is the same as or obvious from the product of the prior art, even if the prior product was made by a different process. *In re Thorpe*, 777 F.2d 695, 697, 227 USPQ 964, 966 (Fed. Cir. 1985). A product-by-process limitation adds no patentable distinction to the claim, and is unpatentable if the claimed product is the same as a product of the prior art.

16. For claims 18 and 19, the examiner notes, a recitation of the intended use of the claimed invention must result in a *structural* difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey G. Hoekstra whose telephone number is (571) 272-7232. The examiner can normally be reached on Monday through Friday, 8:00 a.m. to 5:00 p.m. EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max F. Hindenburg can be reached on (571) 272-4726. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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